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MORRIS E. COHEN
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OFFICE OF PETITIONS

In re Application of
Joseph Tesler
Application No. 09/829,619
Filed: April 10, 2001
Attorney Docket No. 1481.007

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:
: DECISION ON PETITION
: UNDER 37 CFR 1.78(a)(3)
:

This is a decision on the petition under 37 CFR 1.78(a)(3), filed June 2, 2003 and supplemented on June 12, 2003, to accept an unintentionally delayed proper claim under 35 U.S.C. § 120 for the benefit of priority to prior-filed nonprovisional Application No. 09/792,474 as set forth in the amendment filed concurrently with the instant petition.

The petition is **GRANTED**.

A petition for acceptance of a claim for late priority under 37 CFR 1.78(a)(3) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR 1.78(a)(2)(ii). In addition, the petition under 37 CFR 1.78(a)(3) must be accompanied by:

- (1) the reference required by 35 U.S.C. § 120 and 37 CFR 1.78(a)(2)(i) of the prior-filed application(s), unless previously submitted;¹
- (2) the surcharge set forth in § 1.17(t); and
- (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and the date the claim was filed was unintentional. The Commissioner may require

¹ Any nonprovisional application or international application designating the United States of America claiming the benefit of one or more prior-filed copending applications or international applications designating the United States of America must contain or be amended to contain a reference (amendment to the first line of the specification following the title or in an application data sheet (ADS) to each such prior-filed application, identifying it by application number (consisting of the series code and serial number) or international application number and international filing date and indicating the relationship of the applications. Cross references to other related applications may be made when appropriate (see § 1.14).

additional information where there is a question whether the delay was unintentional.

The instant pending application was filed on April 10, 2001, and was pending at the time of filing of the instant petition. A reference to the above-noted, prior-filed nonprovisional application has been included in an amendment to the first sentence of the specification following the title, as required by 37 CFR 1.78(a)(2)(iii).

The instant nonprovisional application was filed after November 29, 2000, and the claim herein for the benefit of priority to the above-noted, prior-filed nonprovisional application is submitted after expiration of the period specified in 37 CFR 1.78(a)(2)(ii). Also, the reference to the above-noted, prior-filed application was submitted during the pendency of the instant nonprovisional application. See 35 U.S.C. § 120. Accordingly, having found that the instant petition for acceptance of an unintentionally delayed claim for the benefit of priority under 35 U.S.C. § 120 to the above-noted, prior-filed nonprovisional application satisfies the conditions of 37 CFR 1.78(a)(3), the petition is granted.

A corrected Filing Receipt, which includes the priority claim to the prior-filed applications, was previously mailed to applicant.

The granting of the petition to accept the delayed benefit claim to the prior-filed application(s) under 37 CFR 1.78(a)(3) should not be construed as meaning that the instant application is entitled to the benefit of the prior-filed application(s). In order for the instant application to be entitled to the benefit of the prior-filed application(s), all other requirements under 35 U.S.C. § 120 and 37 CFR 1.78(a)(1) and (a)(2) must be met. Similarly, the fact that the corrected Filing Receipt accompanying this decision on petition includes the prior-filed applications should not be construed as meaning that applicant is entitled to the claim for benefit of priority to the prior-filed applications noted thereon. Accordingly, the examiner will, in due course, consider this benefit claim and determine whether the instant application is entitled to the benefit of the earlier filing date.

As authorized, the \$1,300 fee required by 37 CFR 1.78(a)(3)(ii) will be charged to petitioner's Deposit Account No. 50-1604.

In the supplemental petition filed June 12, 2003, petitioner states that it has come to his attention in a pre-OG notice, which clarifies how benefit claims must be presented in applications, that it is current Office practice not to require a petition and surcharge if a benefit claim was included in the application although not in the manner specified by 37 CFR 1.78(a) within the time period specified in 37 CFR 1.78(a) and the information was recognized by the Office as shown by its inclusion on the Filing Receipt. Because the benefit claim was presented in the application at

the time of filing and a corrected Filing Receipt was issued on September 17, 2002 recognizing the priority claim and relationship between the applications, petitioner is of the opinion that a petition and surcharge to afford priority benefits to the instant application are not required.

Petitioner is correct in that, if the Office recognizes the claim for benefit of prior-filed applications as noted on the Filing Receipt, although not set forth in the manner provided for in 37 CFR 1.78(a), that no petition and surcharge would be required. However, in the instant case, the Office did not recognize the claim for priority to prior-filed nonprovisional Application No. 09/792,474 in the initial Filing Receipt issued as it did not properly set forth its relationship to the instant application. In reviewing the file, it is noted that a request for a corrected Filing Receipt to include the claim for the benefit of priority to Application No. 09/792,474 was facsimile transmitted to the Office on September 4, 2002, which, at that time, set forth the relationship between the two applications. Further, the request was not made within the time period provided by 37 CFR 1.78(a)(ii). The clarification in the OG and the USPTO website of how benefit claims must be presented stated that, "if a benefit claim is submitted without the specific relationship between the nonprovisional applications before the expiration of the period, and the specific relationship between the nonprovisional applications is subsequently submitted after the expiration of the period, a petition and the surcharge would be required." Therefore, since a proper claim for the benefit of priority herein was not submitted until after expiration of the period set forth in 37 CFR 1.78(a)(2)(i), a petition and surcharge are necessary in order to now afford this application the benefit of the prior-filed applications.

Any inquiries concerning this decision may be directed to the undersigned at (703) 305-8680.

This application is being forwarded to Technology Center Art Unit 2854 for appropriate action on the reply to the November 29, 2002 Office action received June 2, 2003 and for consideration by the Examiner of applicant's claim for the benefit of priority to the prior-filed applications set forth in the amendment of June 2, 2003.



Frances Hicks

Petitions Examiner

Office of Petitions

Office of the Deputy Commissioner
for Patent Examination Policy